

CS



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,704	04/27/2000	Michael D. Zoeckler	7137	2557

7590 11/17/2004

STEVE M. McLARY, ESQ.  
GRAPHIC PACKAGING INTERNATIONAL, INC.  
814 LIVINGSTON COURT  
MARIETTA, GA 30067

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance  
With 37 CFR 1.192(c)**

Application No.

09/559,704

Applicant(s)

ZOECKLER, MICHAEL D.

Examiner

Christopher R Harmon

Art Unit

3721

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on 01 November 2004 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
  - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet



**EUGENE KIM  
PRIMARY EXAMINER**

Continuation of 9. Other (including any explanation in support of the above items): New rules govern the form of the Appeal:

Final Rules, Federal Register Notices, and Official Gazette Notices are available on the USPTO web site at:

<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>

[alternative text: screenshot of Internet webpage entitled "Recent Patent-Related Notices".]

Final Rules: Practice Before the BPAI

Effective Date: September 13, 2004

Generally, any paper filed by applicants or mailed by the Office on or after September 13, 2004 must comply with the revised or new rules.

Appeal briefs filed prior to September 13, 2004 must either comply with former § 1.192 or new § 41.37.

Certificate of mailing or transmission in compliance with § 1.8 will be applicable to determine if a paper was filed prior to the effective date in order to determine which rule applies.

For more information concerning the effective date, see OG notice, Clarification of the Effective Date Provision in the Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule), available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/www.uspto.gov>.

New part 41 for rules relating to appeals and practice before BPAI:

General Provisions - subpart A, §§ 41.1-41.20.

Ex Parte Appeal - subpart B, §§ 41.30-41.54.

Inter Partes Reexamination Appeal - subpart C, §§ 41.60-41.81.

Contested Cases (including interferences) - subpart D, §§ 41.100-41.158.

Patent Interferences - subpart E, §§ 41.200-41.208.

Section 1.191 has been revised to refer to part 41.

Sections 1.192-196 have been deleted.

Subpart B - Ex Parte Appeals:

Definitions - § 41.30.

Appeal to Board - § 41.31.

Amendments and affidavits or other evidence after appeal - § 41.33.

Jurisdiction over appeal - § 41.35.

Appeal brief - § 41.37.

Examiner's answer - § 41.39.

Reply brief - § 41.41.

Examiner's response to reply brief (supplemental examiner's answer) - § 41.43.

Oral hearing - § 41.47.

Decisions and other actions by the Board - § 41.50.

Rehearing - § 41.52.

Action following decision - § 41.54.

Significant Changes for Ex Parte Appeals:

1. The standard for entering affidavits or other evidence submitted after a final rejection now are set forth in §1.116(e) and §41.33(d)(1) & (d)(2).

2. The requirements of the content and format of the appeal brief have been revised (§41.37).

3. Examiner's answer may include a new ground of rejection (§41.39).

o Appellant may request that prosecution be reopened (§41.39(b)) when the examiner's answer includes a new ground of rejection.

4. Supplemental examiner's answer is permitted to respond to any new issue raised in the reply brief (§41.43).

5. After a BPAI remand for further consideration of a rejection, if an examiner's answer is written, appellant may request that prosecution be reopened (§41.50(a)(2)).

The practice for amendments filed after final action, but prior to the date of filing a brief, has not changed (§§1.116 and 41.33(a)).

Sections 41.33(a), (b) & (c) apply to amendments.

Sections 41.33(d)(1) & (d)(2) apply to affidavits and other evidence.

[Alternative text: time line showing Final Rejection, Notice of Appeal, Filing of Appeal Brief and Decision. 37 CFR 1.116 applies between the date of Final Rejection and the Filing of the Notice of Appeal. 37 CFR 41.33(a) which references 37 CFR 1.116 applies after the date of filing the Notice of Appeal to prior to the date the Appeal Brief is filed. §§ 41.33(b),(c) & (d)(2) applies from the date the Appeal Brief is filed to the date of the decision.]

Final Rules: Practice Before the BPAI

Amendments - §1.116 and §41.33(a)

The practice for amendments filed after final action, but prior to the date of filing a brief, has not changed (§1.116 and §41.33(a) have the same standard for entry).

o Amendments filed after the mailing of a final Office action, but prior to the date of filing a brief, may be admitted only to:

§ Cancel claims;

§ Comply with any requirement of form expressly set forth in a previous action;

§ Present rejected claims in better form for consideration on appeal; or

§ Amend the specification or claims upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

o If an amendment filed after final action, but prior to the date of filing an appeal brief, is denied entry, an advisory action (PTOL-303) will be mailed to notify the applicant of the reason for non-entry.

o Examiner may enter an amendment filed after final action, but prior to the date of filing an appeal brief, that places the application in condition for allowance.

Final Rules: Practice Before the BPAI

Amendments - §41.33(b) & (c)

New § 41.33(b) provides that amendments filed on or after the date of filing an appeal brief may be admitted only to:

- o Cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or
- o Rewrite dependent claims into independent form.

§ No limitation of a dependent claim can be excluded in rewriting that claim into independent form.

New § 41.33(c) provides that all other amendments filed after notice of appeal will not be entered,

- o With a few exceptions, e.g., applicant requests that prosecution be reopened where the examiner's answer includes a new ground of rejection.

Final Rules: Practice Before the BPAI

Affidavits or Other Evidence - § 1.116(e)

Rule 1.116 now specifically applies to affidavits or other evidence

Affidavits or other evidence filed after final action, but before or on the date of filing a notice of appeal, may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented (§ 1.116(e)).

- o Other evidence includes declarations and exhibits, but not IDSs (which are treated in accordance with §§ 1.97 and 1.98).

Final Rules: Practice Before the BPAI

Affidavits or Other Evidence - §41.33(d)(1)&(d)(2)

Affidavits or other evidence filed after the date of filing a notice of appeal, but prior to the date of filing a brief, (§41.33(d)(1)) may be admitted if the examiner determines that:

- o A showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made; and

- o The affidavit or other evidence overcomes all rejections under appeal.

Section 41.33(d)(2) provides that all other affidavits or other evidence filed after the date of filing a notice of appeal will not be entered,

- o With a few exceptions, e.g., applicant requests that prosecution be reopened where the examiner's answer includes a new ground of rejection.

Final Rules: Practice Before the BPAI

Appeal Brief - § 41.37

Appeal Brief - copy requirement and time for filing (§ 41.37)

One copy of the brief is required rather than three copies consistent with the implementation of IFW.

The brief is required to be filed within two months from the date of filing of the notice of appeal.

- o The time allowed for reply to the action from which the appeal was taken is no longer relevant.

The time period for filing the brief is extendable under:

- o §§ 1.136(a) & (b) for patent applications (e.g., may extend up to five months after the two month time period); and
- o § 1.550(c) for ex parte reexamination proceedings. See §41.37(e).

Final Rules: Practice Before the BPAI

Appeal Brief - § 41.37

Appeal Brief - effective date impact

An appeal Brief filed on or after September 13, 2004 must be in compliance with the requirements of § 41.37(c).

An appeal Brief filed prior to September 13, 2004 must either be in compliance with the requirements set forth in former § 1.192 or new §41.37(c).

If an appeal brief filed prior to the effective date fails to comply with former § 1.192 and the Office mails a notice requiring correction(s), an amended brief that complies with either former § 1.192 or § 41.37(c) would be acceptable.

If appellant reinstates the appeal on or after the effective date, the second appeal brief must be in compliance with the requirements of §41.37(c).

Final Rules: Practice Before the BPAI

Appeal Brief - § 41.37

Content and format of the appeal brief (§ 41.37)

The brief must contain the following items (§ 41.37(c)):

1. Real party in interest (similar to former § 1.192).

§ A statement identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest.

2. Related appeals and interferences (similar to former § 1.192).

§ Identification of all other prior and pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision.

3. Status of claims (similar to former § 1.192).

§ The status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of the appealed claims.

4. Status of amendments (same as former § 1.192).

§ A statement of the status of any amendment filed subsequent to final rejection.

5. Summary of claimed subject matter (replacing "summary of invention").

§ A concise explanation of the subject matter defined in each of the independent claims involved in the appeal,

§ Must refer to the specification by page and line number, and to the drawing, if any, by reference characters.

- § For each independent claim involved in the appeal and for each dependent claim argued separately,
- § Every means plus function and step plus function must be identified, and
- § The structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.
- 6. Grounds of rejection to be reviewed on appeal (replacing "issues for review" and "grouping of claims").
- § Example: Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X.
- 7. Argument (has been revised).
- § A separate heading is required for each ground of rejection.
- § Any claim(s) argued separately should be placed under a subheading.
- § A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.
- § When multiple claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.
- 8. Claims appendix (similar to former § 1.192).
- § A copy of the claims involved in the appeal.
- 9. Evidence appendix (new)
- § Copies of any evidence entered and relied upon in the appeal.
- 10. Related proceedings appendix (new)
- § Copies of decisions rendered by a court or the Board in any proceeding identified in the related appeals and interferences section.

Final Rules: Practice Before the BPAI

Appeal Brief - § 41.37

Non-compliant appeal briefs (§ 41.37(d))

If a brief does not comply with the requirements set forth in § 41.37, the appellant will be notified of the reasons for noncompliance.

o Appellant will be given 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer, to file an amended brief. See §41.37(d).

o The time period for filing the amended brief is extendable under:

§ §§ 1.136(a) and (b) for patent applications (e.g., may extend up to five months after the two month time period); and

§ § 1.550(c) for ex parte reexamination proceedings. See §41.37(e).

Final Rules: Practice Before the BPAI

Examiner's Answer - § 41.39

A new ground of rejection is now permitted in an examiner's answer mailed on or after September 13, 2004 (§41.39(a)(2)).

o A new ground of rejection should be rare, rather than a routine occurrence.

Any new ground of rejection made in an answer must be:

1. Approved by a Technology Center Director or designee; and

2. Prominently identified (e.g., a separate heading with all capitalized letters) in the following sections of the answer:

§ Grounds of Rejection to be Reviewed on Appeal section; and

§

Grounds of Rejection section.

Final Rules: Practice Before the BPAI

Examiner's Answer - § 41.39

Appellant options if examiner's answer includes a new ground of rejection (§41.39)

If an examiner's answer contains a new ground of rejection, appellant must, within two months, either:

1. Request that prosecution be reopened by filing a § 1.111 reply ; or

2. Request that the appeal be maintained by filing a reply brief.

§ The two month time period under § 41.39 is not extendable under §1.136(a).

3. If appellant fails to take action, the appeal will be sua sponte dismissed as to the claims subject to the new ground of rejection.

Final Rules: Practice Before the BPAI

Reply Brief - § 41.41

Appellant has a right to file a reply brief (§ 41.41)

Appellant may file a reply brief to an examiner's answer within two months from the mailing of the examiner's answer. See § 41.41.

If examiner provides a supplemental examiner's answer to respond to a reply brief, appellant may file another reply brief within two months from the mailing of the supplemental examiner's answer. See § 41.43(b).

Extensions of time under § 1.136(a) are not available for filing a reply brief.

Final Rules: Practice Before the BPAI

After reply brief - a supplemental examiner's answer is now permitted to respond to any new issue raised in the reply brief (37 CFR 41.43)

If the reply brief includes new issues (e.g., appellant for the first time argues that the secondary reference is nonanalogous art), the examiner may either:

1. Withdraw the final rejection and reopen prosecution; or

2. Furnish a supplemental examiner's answer (mailed on or after September 13, 2004) responding to any new issue raised in the reply brief.

A Technology Center Director or designee must approve every supplemental examiner's answer. A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

Final Rules: Practice Before the BPAI

## Appellant's Options After a Remand - § 41.50(a)(2)

If a supplemental examiner's answer is written after a BPAI remand, appellant may request that prosecution be reopened pursuant to § 41.50(a)(2) if:

1. The remand by the Board is for further consideration of a rejection; and
2. The date of the remand is on or after the September 13, 2004.

Appellant may not request that prosecution be reopened:

1. If the Board remands the application prior to September 13, 2004; or
2. If the Board remands the application for a reason other than for further consideration of a rejection.

Final Rules: Practice Before the BPAI

## Appellant's Options After a Remand - § 41.50(a)(2)

Appellant must, within two months from the mailing of a supplemental examiner's answer written in response to a remand by the Board for further consideration of a rejection, either:

1. Request that prosecution be reopened by filing a reply § 1.111, or
2. Request that the appeal be maintained by filing a reply brief.

§ The two month time period under § 41.50(a)(2) is not extendable under § 1.136(a).

If appellant fails to take action, the appeal will be sua sponte dismissed as to the claims subject to the rejection for which the Board has remanded for further consideration.

See §41.50(a)(2).

Final Rules: Practice Before the BPAI

## Suggesting an interference - § 41.202

Suggesting an interference is proposing rejection of someone else's claim, requiring precision in the statement of the rejection (37 CFR 41.202(a))

The claimed inventions must be the same: Claim A would anticipate or render obvious the subject matter of claim B and vice versa

Each "same" invention defines a count.

Every claim involved in the interference must be anticipated by, or obvious over, a count.

There must be an explanation of why the targeted application or patent will lose under 35 U.S.C. 102(g)(1).

A patentee cannot suggest an interference directly (see § 41.202(b)).

An examiner may require an applicant to add an interfering claim: failure to comply will result in forfeiture of the subject matter of the proposed claim.

A showing of priority may show why the applicant was first or why the targeted application or patent is not entitled to its effective filing date.

Final Rules: Practice Before the BPAI

## Effect of judgment - § 41.127

Judgment:

- o Ends the interference
  - o Is required for judicial review
- Adverse judgment:
- o Finally disposes of a claim
  - o Creates an estoppel within the Office from taking action inconsistent with the judgment
- § including remedies that could have been, but were not, sought during the interference
- May include a recommendation to the examiner for further action

Final Rules: Practice Before the BPAI

## Subpart A - General Provisions:

Policy - § 41.1.

Definitions - § 41.2.

Petitions - § 41.3.

Timeliness - § 41.4.

Counsel - § 41.5.

Public availability of Board records - § 41.6.

Management of the record - § 41.7.

Mandatory notices - § 41.8.

Action by owner - § 41.9.

Correspondence addresses - § 41.10.

Ex parte communications in inter partes proceedings - § 41.11.

Citation of authority - § 41.12.

Fees - § 41.20.

Final Rules: Practice Before the BPAI

## Mandatory Notices - § 41.8

In patent appeals and contested cases, appellant/party must notify the Board of any change to the real party-in-interest within 20 days of the change.

In patent appeals and contested cases, appellant/party must notify the Board of any additional judicial or administrative proceeding that could affect, or be affected by, the Board proceeding that the appellant/party becomes aware of within 20 days of becoming aware of the additional judicial or administrative proceeding.

Final Rules: Practice Before the BPAI

Correspondence Address - § 41.10

Correspondence in an ex parte appeal and an inter partes reexamination should be mailed to the following address:

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
PO Box 1450  
Alexandria, Virginia 22313-1450

Correspondence in a contested case (which includes an interference) should be mailed to the following address:

Mail Stop INTERFERENCE  
Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
PO Box 1450  
Alexandria, Virginia 22313-1450

Final Rules: Practice Before the BPAI

Ex Parte Communications in Inter Partes Proceedings - § 41.11

No ex parte communication about an inter partes reexamination or about a contested case with a Board member, or with a Board employee assigned to the proceeding, is permitted.

Final Rules: Practice Before the BPAI

Citation of Authority - § 41.12

Citations to authority must include:

- o For any U.S. Supreme Court decision, a United States Report citation;
- o For any decision other than U.S. Supreme Court decision, parallel citation to both the West Reporter System and United States Patents Quarterly, whenever the case is published in both; and
- o Pinpoint citations whenever a specific holding or portion of an authority is invoked.

Thank You.